

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

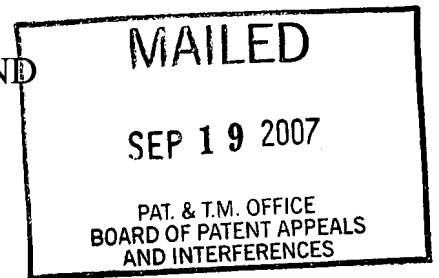
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Ex parte MARK E. ZACHMAN AND  
JERALD W. YOST

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Application No. 10/695,200

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on September 13, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

**APPEAL BRIEF**

**Summary Of Claimed Subject Matter**

Appellant filed an Appeal Brief dated September 30, 2005, in response to the Final Rejection mailed May 24, 2005. The Appeal Brief is not in compliance with

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the new rules of 37 CFR § 41.37(c) effective September 13, 2004. § 37 CFR

§ 41.37(c) states:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

\* \* \*

(c)(1) The brief shall contain the following items...of this section:

(v) ***Summary Of Claimed Subject Matter.*** A concise statement of each ground of rejection presented for review.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief. The Appeal Brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claims argued separately, every means plus functions and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with references to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

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Section 37 CFR§ 41.37(c) further states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

### **EXAMINER'S ANSWER**

#### **Evidence Relied Upon**

The Examiner's Answer mailed February 15, 2006, is defective. The appendix heading "Evidence Relied Upon" (section 8, pg. 3) the Examiner indicates "[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal."

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In accordance with MPEP § 1207.02, the “Evidence Relied Upon” (section 8) should include:

(8) Evidence Relied Upon

A listing of evidence relied on (e.g., patents, publications, admitted prior art), and in the case of non-patent references, the relevant page or pages.

Correction of the record is required, the Examiner may issue a PTOL-90 to identify the evidence relied upon in the rejection of the appealed claim.

Accordingly, it is

**ORDERED** that the application is returned to the Examiner:

- 1) to hold the Appeal Brief of September 30, 2005 defective;
- 2) notify applicants to file a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v);
- 3) consider the paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v); and

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- 4) issue and mail a PTOL-90 having the missing references listed under the Evidence Relied Upon section, heading (8) of the Examiner's Answer: and
- 5) for such further action as may be appropriate.

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By: *Patrick J. Nolan*  
PATRICK J. NOLAN  
Deputy Chief Appeals Administrator  
(571) 272-9797

PJN/dal

cc: DINSMORE & SHOHL, LLP  
ONE DAYTON CENTRE  
ONE SOUTH MAIN STREET  
SUITE 1300  
DAYTON, OH 45402-2023